

REMARKS

By this Amendment, Claims 3 and 4 are amended, and new Claims 18-22 are added. Claims 10-15 stand withdrawn from consideration. Claims 1-22 are pending. Reconsideration of the April 11, 2003 Official Action is respectfully requested.

Applicants propose to amend FIG. 1 of the drawings to change the reference number for the distribution plate from 14 to 214 to be consistent with the description at paragraph [0036], lines 1-2, of the specification.

Applicants affirm that an election was made to prosecute the subject matter of Claims 1-9, 16 and 17.

Claims 1, 2, 5-7, 16 and 17 stand rejected under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. US 2002/0166563 A1 to Jupe et al. ("Jupe"). The reasons for the rejection are stated at pages 3-5 of the Official Action. The rejection is respectfully traversed for the following reasons.

It is asserted in the Official Action that Jupe qualifies as prior art under 35 U.S.C. §102(e) with respect to the present application. Applicants respectfully submit that this assertion is incorrect for the following reasons.

According to 35 U.S.C. §103(c) (see also MPEP §706.02(k), page 700-45 [Feb. 2003 revision]), subject matter is disqualified as prior art under 35 U.S.C. §103 via 35 U.S.C. §102(e) if the subject application was filed after November 29, 1999, and the subject matter and the claimed invention "were, at the time the invention was made, *owned by the same person or subject to an obligation of assignment to the same person*" (emphasis added).

The present application was filed on February 22, 2002, and is assigned to Philip Morris Incorporated. The assignment is recorded at reel/frame: 012860/0316 in the U.S.P.T.O. The Jupe application is assigned to Philip Morris Incorporated. The Assignment is recorded at reel/frame: 012853/0001 in the U.S.P.T.O. Applicants confirm that the subject matter of Jupe and of the claimed invention were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

Accordingly, Jupe does not qualify as prior art under 35 U.S.C. §103 against the claimed invention. Therefore, withdrawal of the rejection is respectfully requested.

Claims 1-3, 7, 9, 16 and 17 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,133,367 to Keritsis in view of U.S. Patent Application Publication No. 2002/0110689 A1 to Hu et al. ("Hu"). The reasons for the rejection are stated at pages 5-6 of the Official Action. The rejection is respectfully traversed for the following reasons.

Claim 1 recites a process for making flavored carbon particles, which comprises "(i) introducing activated carbon particles into a vessel; (ii) introducing a fluidizing gas into the vessel so as to fluidize the activated carbon particles; and (iii) *introducing a liquid flavorant into the vessel while the activated carbon particles are in a fluidized state, the liquid flavorant being absorbed and/or adsorbed onto the activated carbon particles*" (emphasis added). Keritsis and Hu fail to suggest the subject matter recited in Claim 1 for the following reasons.

The Official Action asserts Keritsis discloses that flavorants deposited on activated carbon particles in the filter section of a smoking article are well known in the tobacco art. The Official Action acknowledges that Keritsis fails to disclose flavorants deposited on

carbon particles by introducing a fluidizing gas into a vessel to fluidize the particles, and introducing a flavorant into the vessel to absorb and/or adsorb onto the particles. However, it is asserted that depositing material onto activated carbon particles utilizing a continuous or periodic process, fluidized bed coater is well known and disclosed in Hu. It is further asserted that it would have been obvious to utilize a fluidized bed coating to adsorb flavorant onto carbon particles, which will be incorporated into a filler for a cigarette, "since depositing material on carbon particles via fluidization is known in many arts." Applicants respectfully disagree with these assertions.

Keritsis discloses a container for an additive material for smoking articles. The container is designed to overcome problems encountered when additive materials are added to smoking articles. Keritsis explains that "*menthol and other flavorants deposited on carbon*, silica, and other activated particles in the filler section of a smoking article have been used to impart a flavor or taste to the smoking article" (emphasis added; *see* column 1, lines 33-37, of Keritsis). However, Keritsis fails to disclose how such flavorants are deposited on activated carbon.

Keritsis discourages the use of such additive materials in smoking articles, regardless of how the flavorant may be deposited on the activated carbon. Namely, Keritsis discloses problems that occur when such additive materials are added to smoking articles, as follows:

One of the problems with adding *additive materials* to smoking articles is that the active agents of the additive materials deactivate or volatilize with time so that they do not have the desired effect upon use. Further, *flavor materials* may be extensively trapped by components of the smoking

articles so that less than desired amounts are delivered to the smoker. For example, a significant amount of menthol is trapped on active carbon or in cellulose acetate fibers of a conventional cigarette.... *Another problem* is that the active agents deactivate with the absorption of moisture or other volatile materials during storage or can migrate to the wrapper or embed in the filter or carrier of the smoking article so that they will not modify the smoke characteristics as desired." (Emphasis added. See column 1, lines 42-65.)

Keritsis provides sealed containers containing additive materials for use in smoking articles. The containers have a first condition that is air impervious or sealed, and a second condition that provides for air flow through the container so that the additive material can modify the characteristics of the smoking article in the desired manner (column 3, lines 42-49). Keritsis discloses that any appropriate additive material or combination of materials can be contained inside the container to modify the characteristics of the smoking article, particularly additive materials that have active agents that deactivate over time, or in moist or humid storage conditions, or that evaporate or volatilize or migrate during prolonged storage conditions. Keritsis describes menthol as one such additive material (column 8, lines 4-8).

According to Keritsis, the disclosed containers offer a number of improvements with respect to problems encountered with use of additive materials in smoking articles (column 8, lines 14-37). Keritsis teaches away from providing a flavorant on activated carbon. Keritsis also teaches away from using such flavorant-loaded activated carbon in a smoking article. Keritsis' sealed container, which contains an additive material (without activated carbon) in a sealed condition, is unrelated to providing the additive material in an exposed condition.

It is respectfully submitted that the Official Action fails to consider Keritsis in its entirety, i.e., including those portions that would have led one having ordinary skill in the art away from the claimed invention. See MPEP §2143.03, page 2100-122, right column, first full paragraph. When Keritsis is properly considered in its entirety, it is clear that Keritsis teaches away from the process recited in Claim 1.

Hu fails to cure the above-described deficiencies of Keritsis regarding the process recited in Claim 1. Hu discloses activated carbon particles coated with water-insoluble coating material including a binding agent and a masking agent that can be colored. The colored activated carbon can be placed in absorbent articles in place of uncoated, black activated carbon. Hu fails to disclose or suggest coating *flavorant* onto activated carbon by any process, much less by fluidization, as recited in Claim 1.

As explained in MPEP §2143, to establish a *prima facie* case of obviousness, (1) "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings"; (2) "there must be a reasonable expectation of success"; and (3) "the prior art reference (or references when combined) must teach or suggest all the claim limitations." Moreover, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." The Official Action fails to meet these three requirements, and thus fails to establish a *prima facie* case of obviousness with respect to the process recited in Claim 1.

Keritsis only parenthetically (and without detail) mentions "flavorants deposited on carbon," but otherwise teaches away from depositing a flavorant onto activated carbon. Moreover, Hu fails to suggest applying flavorant onto activated carbon by any process, much less by using a fluidized bed as claimed. Thus, Hu provides no motivation to modify Keritsis to achieve a process as claimed, which includes the feature of "introducing a liquid flavorant into the vessel while the activated carbon particles are in a fluidized state."

In addition, modifying Keritsis in view of Hu in the manner asserted in the Official Action would destroy the intended function disclosed in Keritsis. Keritsis' container maintains the additive material in a sealed condition, while the asserted modification of Keritsis would result in the additive material being exposed, i.e., not in a sealed condition. Because the asserted modification would destroy the intended function disclosed in Keritsis, the cited references provide no suggestion or motivation to make the modification. *See, In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), and *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); and MPEP §2143.01, page 2100-127, left column.

For these reasons, Keritsis and Hu provide no motivation to modify Keritsis to achieve the process recited in Claim 1.

Moreover, even if Keritsis were modified by Hu in the manner asserted in the Official Action, this modification still would not achieve the combination of features recited in Claim 1. At the least, neither Keritsis nor Hu discloses or suggests applying flavorant onto activated carbon by using a fluidized bed.

Accordingly, the Official Action fails to establish a *prima facie* case of obviousness with respect to the process recited in Claim 1. Therefore, Claim 1 is patentable over Keritsis and Hu.

Claims 2, 7, 9, 16 and 17 depend from Claim 1 and, accordingly, also are patentable over Keritsis and Hu for at least the same reasons that Claim 1 is patentable.

Claim 3 has been rewritten in independent form, including the combinations of features of original Claims 1 and 3. Claim 3 is patentable over Keritsis and Hu for at least the same reasons that Claim 1 is patentable. Neither Keritsis nor Hu, alone or in combination, discloses or suggests the combination of features recited in Claim 3 including the feature of "introducing a liquid flavorant into the vessel while the activated carbon particles are in a fluidized state, the liquid flavorant being absorbed and/or adsorbed onto the activated carbon particles."

Claim 4 stands rejected under 35 U.S.C. §103(a) over Keritsis in view of Hu, and further in view of U.S. Patent No. 3,241,520 to Wurster et al. ("Wurster"). The reasons for the rejection are stated at pages 6-7 of the Official Action. The rejection is respectfully traversed for the following reasons.

Claim 4 has been rewritten in independent form, including the combinations of features of original Claims 1 and 4. Claim 4 also is patentable for at least the same reasons that Claim 1 is patentable. Neither Keritsis nor Hu, alone or in combination, discloses or suggests the combination of features recited in Claim 4 including the feature of "introducing a liquid flavorant into the vessel while the activated carbon particles are in a

fluidized state, the liquid flavorant being absorbed and/or adsorbed onto the activated carbon particles."

Claims 5 and 6 stand rejected under 35 U.S.C. §103(a) over Keritsis in view of Hu, and further in view of U.S. Patent No. 3,889,691 to Urbanic et al. ("Urbanic"). The reasons for the rejection are stated at page 7 of the Official Action. The rejection is respectfully traversed for the following reasons.

It is acknowledged in the Official Action that neither Keritsis nor Hu suggests the activated carbon particle size recited in Claims 5 and 6. However, it is asserted that it would have been obvious to utilize activated carbon particles having the claimed particle size in the modified Keritsis process because carbon having the recited size and being utilized in cigarette filters is known in the tobacco art.

Applicants disagree with this assertion. Applicants respectfully submit that Urbanic also fails to cure the deficiencies of Keritsis and Hu with respect to the subject matter recited in Claim 1, from which Claims 5 and 6 depend. Accordingly, Claims 5 and 6 also are patentable. Therefore, withdrawal of the rejection is respectfully requested.

Claim 8 stands rejected under 35 U.S.C. §103(a) over Keritsis in view of Hu, and further in view of "Controlling particle size and release properties" by David M. Jones ("Jones"). The reasons for the rejection are stated at pages 7-8 of the Official Action. The rejection is respectfully traversed for the following reasons.

It is acknowledged in the Official Action that Keritsis as modified by Hu does not suggest a vessel including a gas exhaust conduit separated from the interior of the vessel by a filter, or including periodic blow back of gas through the filter to clean activated carbon

particles from the filter. However, it is asserted in the Official Action that it would have been obvious to utilize a vessel having the combination of features recited in Claim 8 in view of Jones.

Applicants respectfully disagree with these assertions. Applicants respectfully submit that Jones also fails to cure the deficiencies of Keritsis and Hu with respect to the subject matter recited in Claim 1, from which Claim 8 depends. Thus, Claim 8 also is patentable over the cited references. Therefore, withdrawal of the rejection is respectfully requested.

New Claims 18-22 are added. Claims 18, 20 and 22 recite the feature of "the carbon particles are at a temperature of from 40°F to 70°F while the activated carbon particles are in the fluidized state." Support for this feature is provided at page 15, paragraph [0043] of the specification. It is respectfully submitted that Claims 18, 20 and 22 also are patentable.

New Claims 19 and 21 depend from Claims 3 and 4, respectively, and recite the feature of "the process provides 0.1 to 20% by weight of flavorant on the activated carbon particles." Support for Claims 19 and 21 is provided, for example, in original Claim 2. It is respectfully submitted that Claims 19 and 21 also are patentable for at least the same reasons as those for Claims 3 and 4, respectively.

For the foregoing reasons, withdrawal of the rejections and prompt allowance of the application are respectfully requested.

Respectfully submitted,

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Attachment: Annotated Sheet Showing Change